

AUS920010422US1

- I. Claims 1-20, drawn to a method of database or file accessing comprising distributed or remote access, classified in class 707, subclass 10.
- II. Claims 21-40, drawn to a networked electrical computer or digital processing system comprising remote data accessing, classified in class 709, subclass 218.
- III. Claims 41-60, drawn to a data processing apparatus for generating database or data structure (e.g. via user interface), classified in class 707, subclass 102.”

Applicants elect with traverse Group I, claims 1-20, for prosecution in the present case. Applicants respectfully propose for the reasons set forth below that the three inventions as identified in the Office Action in fact are not independent and distinct within the meaning of 35 U.S.C. 121, that the present restriction requirement is therefore incorrect, and that the three inventions as identified in the Office Action should be examined together in the present case.

**Inventions I and II Are Not Related As Process and Apparatus**

The Office Action states that “Invention I is related to each of Inventions II and III, as process and apparatus for its practice.” The Office Action also states that “The inventions are distinct if it can be shown that *either*: (1) the process as claimed can be practiced by another, materially different apparatus, or by hand, or (2) the apparatus as claimed can be used to practice another, materially different process. (MPEP § 806.05(e)).” The Office Action makes no claim that the apparatus as claimed can be used to practice another process. Instead, the Office Action says that the claimed process can be practiced by a different apparatus – including ‘calculating duty’ being performed by hand.

AUS920010422US1

In response, Applicants note with respect that correct restriction analysis according to MPEP § 806.05(e) is to the “process as claimed.” If the analysis is the process as claimed, then in this case it cannot be correct to conclude that the “process as claimed can be ... performed by hand, without aid of any mechanical means or apparatus” because the process as claimed in the present application is directed to creating a master customs planning record in an international customs server in response to a signal from a client device that is equipped for data communications through at least one internet connection to the international customs server. Invention I as identified in the Office Action therefore is not related to Inventions II and III as process and apparatus for its practice.

**Inventions I and III Are Not Related As Process and Apparatus**

The Office Action states that “Invention I is related to each of Inventions II and III, as process and apparatus for its practice.” Invention III as identified, however, claims 41-60, is directed to a “computer program product,” that is, not to an apparatus, but to software as an article of manufacture within the meaning of In re Beauregard, 53 F.3d 1583 (Fed. Cir. 1995). Because Invention III is not directed to an apparatus, Invention I cannot be related to Invention III as process and apparatus for its practice.

**Invention II and III Are Not Related as Combination and Subcombination**

The Office Action states that “Invention II is related to Invention III as combination and subcombination.” A combination is an organization of which a subcombination or element is a part. MPEP § 806.05(a). Invention II claims an apparatus, a computer, a “system for facilitating customs planning a clearance ...” Invention III claims a computer program product, a computer program recorded on a recording medium. A computer program recorded on a recording medium is not an element or part of a computer system. Invention II is not related to Invention III as combination and subcombination, and restriction for this reason is not correct.

AUS920010422US1

**Subcombination Has No Separate Utility**

The Office Action states that Invention II is related to Invention III as combination and subcombination and that the subcombination has separate utility, "such as for use as a paperweight." As mentioned above, Invention III claims a computer program product, a computer program recorded on a recording medium. The computer program product as claimed in the present application has no reasonable or practical separate utility because recording media have no practical use as paperweights – nor do they have any other practical uses other than uses as computer program products. To grant separate utility as a paperweight is to grant separate utility to each and every apparatus or article of manufacture that is heavier than air – because all such objects can be used as paperweights in the broadest sense. The claiming pattern between Inventions II and III is in fact a pattern of claiming system and product aspects of a computer-related invention. This is a very common pattern of claiming, and the rules implementing 35 USC 121 are not intended to separate examination of such closely related aspects of an invention.

**Inventions I, II, and III Are Not Separate in the Art**

The Office Action states that the Inventions I, II, and III "have acquired a separate status in the art as shown by their different classification." The Office Action classified claims 1-20 in class 707, subclass 10; claims 21-40 in class 709, subclass 218; and claims 41-60 in class 707, subclass 102.

Applicants respectfully propose in response that separate status of inventions I, II, and III is not evidenced by their different classification because all three Inventions I, II, and III are properly classified in one class: class 707, subclass 100. The subject matter of class 707, subclass 100, includes "means or steps for organizing and inter-relating data or files, including relational, network, hierarchical, and entity-relationship models, among others." Inventions I, II, and III as identified in the Office Action are directed to method aspects, system aspects, and product aspects respectively of facilitating customs planning and clearance, including organizing data or files in a relational model, that is, with a

AUS920010422US1

customs planning record "related through a foreign key field" to a master customs planning record, and also including inter-relating data or files in a network model, "data communications through at least one internet connection." Because all three inventions are properly classified in one class, there is no basis in different classification for treating them as having any separate status in the art.

**Inventions I, II, and III Are Not Distinct According To MPEP 806.05(e)**

MPEP 806.05(e) states "If the apparatus claims include a claim to "means" for practicing the process, the claim is a linking claim and must be examined with the elected invention." Inventions I, II, and III respectively claim method, system, and product aspects of facilitating customs planning and clearance. As mentioned, this is a common claiming pattern for computer-related inventions, a pattern under which Inventions I, II, and III ought not be subjected to restriction according to 35 U.S.C. 121.

**Examining Inventions I, II, and III Together**  
**Represents No Additional Burden Of Examination**

MPEP § 803 states, "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." As mentioned, Inventions I, II, and III respectively claim method, system, and product aspects in the present application for facilitating customs planning and clearance. This is a common claiming pattern for computer-related inventions that the PTO has examined thousands of times without restriction. This claiming pattern represents no additional burden of examination because all three inventions are correctly classified in class 707, subclass 100.

**Conclusion**

For the reasons set forth above, Applicants respectfully propose that Inventions I, II, and III as identified in the Office Action are not independent and distinct within the meaning

AUS920010422US1

of 35 U.S.C. 121, the present restriction requirement is therefore incorrect, and the three inventions as identified in the Office Action should be examined together in the present case. Applicants traverse the restriction requirement and request examination of all three inventions together in the present case.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

Date: 8.17.04

By:



John Biggers

Reg. No. 44,537

Biggers & Ohanian, LLP

504 Lavaca Street, Suite 970

Austin, Texas 78701

Tel. (512) 472-9881

Fax (512) 472-9887

ATTORNEY FOR APPLICANTS